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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/854,617	05/14/2001	Yohnosuke Furui	JP9-2000-0025-JP1 (8728-5)	9199
22150	7590	04/18/2005	EXAMINER	
F. CHAU & ASSOCIATES, LLC 130 WOODBURY ROAD WOODBURY, NY 11797			POLLACK, MELVIN H	
			ART UNIT	PAPER NUMBER
			2145	
DATE MAILED: 04/18/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/854,617

Applicant(s)

FURUI ET AL.

Examiner

Melvin H Pollack

Art Unit

2145

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 December 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 May 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>11/24/04</u> . | 6) <input checked="" type="checkbox"/> Other: <u>see attached office action</u> . |

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed 12/13/04 have been fully considered but they are not persuasive. The reasons for the maintenance of rejection are provided below, but will concentrate on a detailed description of Knauft and to clarifying the relationships between the items.
2. The examiner has entered the foreign priority claim in response to the petition.
3. The examiner withdraws all 112 rejections, due to ample amending of the claims.
4. Knauft teaches a method (abstract) of providing indexing information to search engines, and documents and/or document description to client computers (col. 1, line 40 – col. 3, line 15). More specifically, there is a server (Figs. 1-3, #110) which holds data objects (Fig. 2, #216) and which may be accessed by an information retrieval (IR) system (Fig. 2, #208) or by a client (Fig. 2, #115) which may or may not be authorized to access the data (Fig. 4, #312; col. 10, line 53 – col. 11, line 5). The server receives and processes requests from these items based on the type of requestor (col. 11, lines 20-60). More specifically, the server uses request identifiers (col. 12, lines 1-10) to determine whether the request comes from a robot (col. 5, line 67; “spider”) from an IR system, from an authorized client, or from an unauthorized client. If it is an IR system, the server creates a metadata document of key words for indexing (Fig. 6, #514; col. 12, lines 45-55) customized based on the type and identity of the IR system (col. 12, line 63 – col. 13, line 5) and on the type of resource to be indexed (col. 13, lines 5-55). If the requestor is an authorized system (col. 13, lines 60-65), the system transmits the main information and not the aforementioned metadata response (col. 14, lines 24-25). If the requestor is not authorized (Fig. 7, #700), the system sends a new meta-document (Fig. 9) which includes a description of the

Art Unit: 2145

object and an option for payment, in which fee payments allow access to the document (col. 14, lines 45-65).

5. Applicant charges that the examiner did not sufficiently explain transmission source determiner and response unit. The server interface (Fig. 3, #218) works with the main engine (Fig. 3, #204) by determining the transmission source identifier (col. 12, lines 1-10), which the main engine then compares to information located in the information retrieval database (Fig. 3, #224) and user database (Fig. 3, #228) (See also col. 8, lines 40-50 and col. 9, lines 5-40), and from server's attached meta-database (Fig. 2, #210) which examiner failed to clarify as being considered part of data object holder #216.

6. Applicant charges that the examiner did not sufficiently explain generating and returning responses consonant with said type, and specifically requested clarification in regards to "vs." The examiner starts by tracing from the decision made by #204 (with assistance from #218) regarding whether a requestor is a search engine (Fig. 6, #506). If yes, step #514 is performed. If no, step #544 (or #700) is performed. The "vs." then was meant to show that two different steps are performed *based* upon the type of request. A particular request can be either #514 or #544, but it cannot be both.

7. A similar response is given for applicant's assertion that examiner did not sufficiently explain "obtaining metadata (as a result of the determination)." The teachings above should sufficiently show how the type of request is used to determine which data to gather.

8. Applicant finally charges that Knauff does not expressly disclose "fees for said subscriber information. The cited material states "an illustrative electronic document 900 is shown that includes... payment information 908 for the source data object, and an acceptance selector

Art Unit: 2145

916.... The server computer 110 determines whether the user 102 agrees to the conditions of access.” From this, and the discussion above, it is clear that the authentication and response is dependent upon payment information.

9. In view of the above remarks, and to the data cited in the prior action, the examiner maintains his rejection. This rejection is final.

Priority

10. Receipt is acknowledged of the petition for acceptance of an unintentionally delayed claim under 35 USC 119 (a) – (d). The petition has been accepted, and the priority date of 15 May 2000 is now granted.

Information Disclosure Statement

11. The information disclosure statement filed 24 November 2004 fails to comply with 37 CFR 1.98(a)(3) because it does not include a concise explanation of the relevance, as it is presently understood by the individual designated in 37 CFR 1.56(c) most knowledgeable about the content of the information, of each patent listed that is not in the English language. It has been placed in the application file, but the information referred to therein has not been considered. The IDS is missing an English language abstract or summary of the Asahi PC article, which is necessary in order to consider the citation.

Claim Rejections - 35 USC § 102

12. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an

Art Unit: 2145

international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

13. Claims 1-16 are rejected under 35 U.S.C. 102(e) as being anticipated by Knauft et al.

(6,654,754).

14. For claims 1, 6, 10, 12, and 14, Knauft teaches (abstract; col. 1, line 40 – col. 3, line 15) a web system (Fig. 1, #110) provided in a communication network (Fig. 1, #116) comprising:

- a. A data manager (Fig. 2, #210 and #216), for storing information to be provided across said communication network (col. 5, lines 55-65);
- b. A transmission source determiner (Fig. 3, #218 in conjunction with #204; col. 6, line 65 – col. 7, line 15), for ascertaining the type of a transmission source (col. 12, lines 1-10) from which an access request is received (Fig. 6, #506); and
- c. A response unit (Fig. 3, #204), for (a) acquiring from said data manager (col. 6, lines 18-25 and 35-40) information correlating with said type (col. 6, lines 15-30) obtained in accordance with the determination made by said transmission source determiner (col. 6, line 65 – col. 7, line 15), and for (b) generating and returning a response consonant with said type (Fig. 6, #514 if type 1, Fig. 6 #544 if type 2)(col. 11, lines 30-60),
- d. Wherein said data manager stores main information (Fig. 2, #216) and metadata for describing main information (Fig. 2, #210) (col. 6, lines 35-45), and
- e. Wherein, as the result of the determination by said transmission source determiner (col. 12, lines 5-20), when said transmission source has no right of access for said main information (Fig. 6, #508), said response unit obtains metadata that is then used to generate a response (Fig. 7, #514 and #532).

Art Unit: 2145

15. For claims 2, 8, 11, 13, and 15, Knauft teaches that when said transmission source comprises a robot (col. 5, line 65 – col. 6, line 17; “spider”) in a robot search engine (Fig. 2, #208) that is launched across said communication network (Fig. 2, #116), said response unit generates the metadata response, and wherein the metadata response comprises a keyword concerning said main information (col. 2, lines 43-53).

16. For claims 3, 9, Knauft teaches that said transmission source determiner includes a user agent register (Fig. 4), wherein said robot and a user agent header that said robot adds to said access request (col. 7, lines 33-65) are registered as correlating with each other (col. 12, lines 1-10), and wherein when said user agent header is registered in said user agent register (Fig. 3, #224; Fig. 11), said transmission source determiner determines said transmission source to be said robot (col. 9, lines 15-30) (IR system #1 gets different response from IR #2).

17. For claims 4, 7, Knauft teaches that said transmission source determiner includes a user register (Fig. 4); wherein each access right of a user for said main information is registered in the user register (col. 10, line 50 – col. 11, line 20); wherein a user ID (col. 12, lines 5-10) and said access request are received (col. 13, lines 65-col. 14, line 15) and registered in said user register, said transmission source determiner notifies said response unit of a range of said access rights of said user indicated in said user register (col. 14, lines 7-15); and wherein said response unit generates a metadata response, comprising text data for describing said main information in accordance with said range (col. 14, lines 10-15).

18. For claim 5, Knauft teaches a web system established in a communication network comprising:

Art Unit: 2145

- a. A data manager (Fig. 2, #216), for storing subscriber information to be provided across said communication network (col. 1, line 55 – col. 2, line 2);
 - b. A transmission source determiner (Fig. 3, #218), for determining whether a user who is the transmission source of an access request has paid a fee for said subscriber information (Fig. 6, #540); and
 - c. A response unit (Fig. 3, #204), for (a) transmitting in accordance with the determination made by said transmission source determiner said subscriber information to a user who has paid said fee for said subscriber information (col. 14, lines 15-37), and (b) transmitting at no cost (Fig. 7, #700) a description of said subscriber information to a user who has not paid said fee (Fig. 9; col. 14, lines 37-65).
19. For claim 16, Knauff teaches that access to said main information is limited (col. 1, line 55 – col. 2, line 2).

Conclusion

20. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

Art Unit: 2145

however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Melvin H Pollack whose telephone number is (571) 272-3887.

The examiner can normally be reached on 8:00-4:30 M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Valencia Martin-Wallace can be reached on (571) 272-6159. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MHP
08 April 2005



VALENCIA MARTIN-WALLACE
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3100